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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,184

11/13/2003

Gerald A. Case

JCA1-H23

9388

7590

09/01/2006

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EXAMINER

TALBOT, MICHAEL

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/714,184

Applicant(s)

CASE, GERALD A.

Examiner

Michael W. Talbot

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 6-8 is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Loerwald '367. Loerwald '367 shows in Figures 1-4 a punch assembly (10) for punching holes in a metal sheet (col. 2, lines 38-41) comprising a mandrel (20,22) having an elongated shaft (20) with a generally constant diameter over its entire length, a distal end (at 22) and a disk-shaped head (at 28) opposite the distal end. Loerwald '367 shows the disk-shaped head defining an outer diameter and a substantially flat face (at 28) defined by a threaded bore (Fig. 3) formed therein. Loerwald '367 shows a generally cylindrical shaped punch (26) comprising a base end (28) defining a substantially flat face having an aperture (30) formed there through the base end and a cutting end (36) terminating in a pair of opposing arcuate portions (42) in alternate space relation with a pair of tip portions (40). Loerwald '367 shows an attachment means comprising a bolt (32) extending through the aperture (30) of the base end of the punch and threadedly engaging the thread bore of the flat face of the disk-shaped head (Fig. 3).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3722

4. Claim 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loerwald '367. Loerwald '367 discloses the claimed invention except for the use of a powder-actuated tool. It would have been obvious to one of ordinary skill in the art at the time invention was made to make the actuation means automatic in lieu of manual for the purpose of increased ease of actuation resulting in repeatable and consistent force delivery, because it has been held that broadly providing a mechanical or automatic means to replace manual activity without producing any new and unexpected results involves only routine skill in the art.

5. Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loerwald '367 in view of Timp et al. '835. Loerwald '367 discloses the claimed invention except for the mandrel head being larger in diameter than the punch base end diameter.

Timp et al. '835 teaches that it is known to have a mandrel (14) head (at 42) larger in diameter than the punch (16) base end (at 12) diameter. In view of this teaching of Timp et al. '835, it would have been obvious to one of ordinary skill in the art to make the mandrel head diameter larger than the punch base end diameter to enhance the integrity and durability of the contact surface area (28) being contacted by the driver (44) thus extending the longevity of the punch assembly.

#### ***Allowable Subject Matter***

6. The following is a statement of reasons for the indication of allowable subject matter:

Claims 1-4 and 6-9 are allowed.

Claim 1 is the sole independent claim.

Regarding claim 1, the prior art of record fails to anticipate or make obvious "a mandrel having a substantially flat faced head defined by a threaded bore formed therein", solely or in combination, with the mandrel further comprising an elongated shaft with a distal end and a disk-shaped head opposite said distal end defining an outer diameter, a generally cylindrical

Art Unit: 3722

shape punch having a base end defining a substantially flat face having an aperture formed therethrough and a cutting end defining a cutting edge terminating in at least one pointed tip and an attachment means for attaching the punch to the mandrel whereby the base end of the punch is in adjacent to the face of the mandrel and a bolt extends through the aperture of the base end of the punch and threadedly engaging the thread bore of the flat face of the mandrel

Loerwald '367 is the closest art of record.

Loerwald '367 shows in Figures 1-4 a punch assembly (10) for punching holes in a metal sheet (col. 2, lines 38-41) comprising a mandrel (20,22) having an elongated shaft (20) with a generally constant diameter over its entire length, a distal end (at 22) and a disk-shaped head (at 28) opposite the distal end. Loerwald '367 shows the disk-shaped head defining an outer diameter and a substantially flat face (at 28) defined by a threaded bore (Fig. 3) formed therein. Loerwald '367 shows a generally cylindrical shaped punch (26) comprising a base end (28) defining a substantially flat face having an aperture (30) formed there through the base end and a cutting end (36) terminating in a pair of opposing arcuate portions (42) in alternate space relation with a pair of tip portions (40). Loerwald '367 shows an attachment means comprising a bolt (32) extending through the aperture (30) of the base end of the punch and threadedly engaging the thread bore of the flat face of the disk-shaped head (Fig. 3).

Loerwald '367 lacks the presence of "a mandrel having a substantially flat faced head defined by a threaded bore formed therein" as set forth in independent claim 1. Although it is well known to have a threaded bore defined in a flat faced head of a mandrel member, there is no teaching in the prior art of record that would, reasonably and absent impermissible hindsight, motivate one having ordinary skill in the art to so modify the teachings of Loerwald '367, noting that in Loerwald '367, the head of the mandrel lacks a threaded bore formed therein. Thus, for

Art Unit: 3722

at least the foregoing reasons, the prior art of record neither anticipates nor rendered obvious the present invention as set forth in independent claim 1.

***Response to Arguments***

7. Applicant's arguments filed 20 June 2006 with respect to Loerwald '367 and claims 9-14 have been fully considered but they are not persuasive. Loerwald '367 clearly shows a disk-shaped head (at 28) and the punch clearly shows a flat base end (28) adjacent to the dish-shaped head of the mandrel.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's argument that the Loerwald '367 reference fails to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., "a uni-directional punch" and "use of a powder-actuated tool" as cited on page 9/11 of Applicant's arguments) is not recited in rejected independent claim 14. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. Applicant's arguments filed 20 June 2006 with respect to Timp et al. '835 and claims 1 and 2 under 35 USC 102, with respect to Ducret '063 and claims 9-11 and 14 under 35 USC 102, with respect to Timp et al. '835 in view of Adleman et al. '722 and claims 3,4 and 6-8 under 35 USC 103, with respect to Ducret '063 and claim 12 under 35 USC 103, with respect to

Art Unit: 3722

Ducret '063 in view of Timp et al. '835 and claim 13 under 35 USC 103 have been fully considered and are persuasive. The rejection with respect to the specific references and the respective claims has been withdrawn.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT  
Examiner  
28 August 2006



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SUPERVISORY PATENT EXAMINER